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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/612,055	07/07/2000	Joseph H. Sklar	SKLAR-21	6809

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EXAMINER

BUMGARNER, MELBA N

ART UNIT	PAPER NUMBER
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3732

DATE MAILED: 07/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/612,055	Applicant(s) SKLAR, JOSEPH H.	
	Examiner Melba Bumgarner	Art Unit 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-18,20,21 and 23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-18,20,21 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 14-17, 20, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luscombe et al. (5,683,418). Luscombe et al. disclose a ligament shim for insertion into a bone tunnel comprising a body 100 having a first end and a second end, and an axis extended from the first end to the second end, the first and second ends being substantially planar, the first and second ends having a length and a central width, the length being longer than the central width, a first surface and a second surface extending from the first end to the second end and substantially parallel to the axis, a shim hole 102 extending from the first surface to the second surface, the body being devoid of any further opening, and a third surface and a fourth surface, both being outwardly rounded and extending from the first end to the second end (figure 13); however, they do not show the first surface being arc-shaped in this embodiment. Luscombe et al. teach a ligament shim comprising at least the first surface (actually both surfaces) being arc-shaped (figures 1 and 2). It would have been obvious to one of ordinary skill in the art to modify the embodiment of above with the arch-shaped surfaces in order to match the size of the bore hole provided in the bone in view of Luscombe et al. The first arc-shaped surface extends outwardly from the axis. The second surface is a flat surface. As modified the hole extends from a crest of the first surface to the second surface. It would have been an obvious matter of choice to one of

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ordinary skill in the art as to the shape of the first surface and second surface being arc-shaped and opposed to each other with the first surface extending outwardly from the axis and the second surface extending inwardly toward the axis, in that the disclosure does not show an embodiment of such first and second surface with two outwardly rounded surfaces extending from the first end to the second end. Furthermore, the shape is dependent upon its intended use in the bone tunnel.

3. Claims 18 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sklar et al. (WO 98/23229) in view of Luscombe et al. (5,683,418). Sklar et al. disclose a ligament shim comprising a body 48 having a first end and a second end, and an axis extended from the first end to the second end, the first and second ends being substantially planar, the first and second ends having a length and a central width, the length being longer than the central width, at least a first surface and a second surface extending from the first end to the second end and substantially parallel to the axis, the first and second surfaces are arc-shaped and are opposed surfaces extending inwardly toward each other adapted to received ligaments on opposing sides of the body (figures 8 and 9); however, they do not show a shim hole. Luscombe et al. teach a shim comprising a hole 5 extending from the first surface to second surface, the body being devoid of further opening. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the shim of Sklar et al. with the hole as in Luscombe et al. in order to be able to guide a suture through the opening to aid in positioning and securing the shim in position in view of Luscombe et al. Sklar et al. show a third surface and a fourth surface, the third and fourth surfaces both being outwardly rounded and extending from the first end to the second end.

Response to Arguments

4. Applicant's arguments filed April 27, 2006 have been fully considered but they are not persuasive. The structural limitations of the claims are shown in the prior art references. Applicant argues the placement of a locking member to position the ligament(s) in the prior art, not that of the shim which may be positioned and secured as modified with the aid of an opening. It is noted that the applicant's specification describes the claimed invention taking the form of a shim both without and with a shim hole for the same intended purpose.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melba Bumgarner whose telephone number is 571-272-4709. The examiner can normally be reached on Mon-Fri.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached at 571-272-4720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Melba Bumgarner
Primary Examiner